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1 RECORD OF ORAL HEARING
2 UNITED STATES PATENT AND TRADEMARK OFFICE

3
4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES

6
7 Ex parte DAVID G. BARKALOW,
8 MICHAEL A. REED,
9 ROBERT B. FRIEDMAN,
10 ELENA S. MIRZOEVA,
11 JULIUS W. ZUEHLKE,
12 and ROBERT J. YATKA
13

14 Appeal 2008-1517
15 Application 10/617,905
16 Technology Center 1700
17

18
19 Oral Hearing Held: April 17, 2008
20

21
22 Before EDWARD C. KIMLIN, BRADLEY R. GARRIS, and
23 KAREN M. HASTINGS, Administrative Patent Judges
24

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1 The above-entitled matter came on for hearing on Thursday,
2 April 17, 2008, commencing at 11:00 a.m., at the U.S. Patent and Trademark
3 Office, 600 Dulany Street, Alexandria, Virginia, before Dawn A. Brown,
4 Notary Registration No. 7066896, Notary Public.

5 THE CLERK: Calendar Number 48, Mr. Shurtz.

6 JUDGE KIMLIN: Good morning, Mr. Shurtz.

7 MR. SHURTZ: Good morning.

8 JUDGE KIMLIN: Last but not least.

9 MR. SHURTZ: Yes.

10 JUDGE KIMLIN: We have some chewing gum today?

11 MR. SHURTZ: I've brought a sample if you'd like it.

12 JUDGE KIMLIN: We are looking forward to it.

13 MR. SHURTZ: Yes. I appreciate the opportunity to address
14 the Board today. I'd like to acknowledge also the presence of a
15 representative from my client, Rebecca, is here with me today. Although I
16 told her she couldn't get up and cheer if I scored any points.

17 I'd like to -- I'm sure you've read the brief and understand the
18 invention, but just as a way of introducing my remarks, I think it is a little bit
19 easier to do so if I've had a chance to reiterate a few of the points that are in
20 the brief regarding the invention and how it came about.

21 The concept of coated chewing gum products, all well known.
22 Particularly sugar-coated products have been around for many years. This
23 invention relates more to the area of sugarless coatings. And as people have
24 worked on trying to make noncariogenic products. They wanted to have
25 products that were coated -- sugarless coating.

26 In doing so, they found those types of coating products were

1 harder to make. People have worked on that. There are numerous patents
2 that describe different sugarless coatings and how you try to achieve that.
3 The two prior art references that have been applied by the examiner in this
4 case were examples of those where people were trying to use sorbitol in
5 making a sugarless coating.

6 The inventors were trying to find ways to improve sugarless
7 coatings, particularly those used with maltitol, and trying to the reduce the
8 cost is one of the things because maltitol was somewhat expensive. But they
9 recognized there was problems also -- if you are coating with sugarless
10 sweeteners, it is often -- the coating process is more difficult, more time
11 consuming.

12 If you use a dry charge, that was one expedient way of trying to
13 improve the process. But typically a dry charge is used in the coating
14 process that is the same chemical constituent as the syrup. If you use
15 maltitol in the syrup, you'd use maltitol in the dry charge. That is what had
16 been done here before, where the inventors started their work.

17 But nonetheless, as they thought about ways to improve that,
18 they considered including some other materials in the dry charge, and
19 particularly a filler.

20 But they expected that the coating quality would be reduced
21 because when you are trying to form a coating on a chewing gum product,
22 you want the crystallization process to occur, and these other ingredients that
23 you might add to the coating process, if they weren't the same chemical
24 constituent as the main sugarless alcohol that you were using -- sugar
25 alcohol you were using, would cause problems in crystallization.

26 Nonetheless, they found that they could use the filler and found

1 they could use high levels of filler. Not only could they do that and get the -
2 - a reduced cost, but they found unexpected results in that it improved -- the
3 coating times were reduced and the coating quality was improved.

4 So the prior art has been applied. There are two references. I
5 refer to them as Cherukuri 510 and Cherukuri 838, and in my mind, they're
6 similar references and the teachings are not necessarily any different.

7 The first Cherukuri reference, they use two different syrups,
8 one main coating syrup to do most of the building up of the coating layer on
9 the gum and the second coating syrup was used as a finishing syrup.

10 The second Cherukuri reference, they said, Let's try to create
11 one syrup that can be used throughout the whole coating process. In both
12 disclosures, they have a similar discussion regarding the dry charge material
13 that they use and there is no real difference. So I won't make a distinction
14 with regard to the two references.

15 In the Cherukuri prior art, their dry charge material included 40
16 to 90 percent sweetener, 5 to 30 percent of a moisture absorbing compound,
17 2 to 20 percent of an anti-sticking agent, and 2 to 12 percent of a dispersing
18 agent. They mentioned you could use calcium carbonate for the anti-
19 sticking agent.

20 And the examiner's position in rejecting the claims was even
21 though we called for 40 to 80 percent of a filler, which could be calcium
22 carbonate, and the prior art only disclosed 2 to 20 percent, he said it would
23 have been obvious to increase the level of filler or anti-sticking agent in the
24 prior art just because you've tried to optimize cost savings.

25 Now, I think in the -- from the legal standpoint, there is a
26 fallacy in the, arguably, prima facie case the examiner has laid out.

1 That is that a person of ordinary skill in the art reading
2 Cherukuri would not have wanted to increase, even for cost-saving reasons,
3 the amount of anti-sticking agent that was being used. There is a reason to
4 use an anti-sticking agent, and Cherukuri doesn't explain in great detail why.
5 The only reference we know why it was being used is by the name anti-
6 sticking agent.

7 So a person of ordinary skill in the art would say, how much
8 anti-sticking agent do I use? Well, I only need to use enough to prevent the
9 sticking, and anything else that I use will probably have a negative impact
10 on the coating quality.

11 So I believe a person of ordinary skill in the art would not have
12 been inclined to try to optimize and use more than 20 percent. And
13 therefore, I think the prima facie case of obviousness isn't applicable here.

14 There are some problems, and we pointed out on pages 8 to 10
15 of our brief, with using some other ingredient besides the main, in this case,
16 maltitol that is in your coating surface, using something different in the dry
17 charge material.

18 And those are that you would have -- get negative taste impact
19 if you're using something else besides your sweetener. You would have --
20 expected that you would get coating properties that wouldn't be as good.
21 That would make the process more difficult. It would interfere with the
22 crystallization process, which is the main process that is involved in this
23 coating operation.

24 And especially, when I think of an anti-sticking agent, I think it
25 is going to make the next layer of coating syrup harder to apply and harder
26 to stick if I have a large amount of anti-sticking agent in my dry charge

1 material that I've used.

2 Now, all of these points that were raised in our appeal brief the
3 examiner has not refuted as to why it wouldn't have been obvious. His
4 simple argument was cost efficiency. It would have been less costly to use
5 calcium carbonate than maltitol in the dry charge.

6 JUDGE KIMLIN: Is there any evidence of record to support
7 your assertion that more anti-sticking agent wouldn't be a good thing? It
8 seems speculative on your part.

9 MR. SHURTZ: Okay. In our -- in the record we developed,
10 we presented that argument that we believe that a person of ordinary skill in
11 the art would not have wanted to use more. I don't think we cited any
12 specific reference, nor was there any counter-reference ever cited by the
13 examiner.

14 JUDGE KIMLIN: I think the examiner's position is that in
15 general it is a matter of obviousness to include more of a filler of any type as
16 a cost-reduction method realizing, of course, that you were going to lose
17 some of the benefits associated with the other ingredients. And that it is a
18 matter of optimization by one skilled in the art contingent upon the quality
19 of the product desired.

20 MR. SHURTZ: What this invention has to do with is the
21 quality of the product. So to be able to get a high-quality product, a person
22 of ordinary skill in the art wouldn't have thought, well, I'm going to increase
23 the anti-sticking agent. They might have thought I can increase it for cost,
24 but if they wanted to make a quality product, they wouldn't have thought to
25 increase it.

26 JUDGE KIMLIN: So the issue arises, is there evidence that

1 compares your product with having more filler in it with the product of the
2 prior art having less filler?

3 MR. SHURTZ: No. That was the next point I wish to get into.
4 In the work that was done and in the application that was filed, we submitted
5 evidence to show the unexpected result that the inventors found.

6 When they did this work, they were surprised to say, wait a
7 minute. We can go up to 40 to 80 percent filler in the dry charge, and not
8 only do we get the cost savings, but we get improved properties, we get
9 improved appearance, we get improved corner chipping, we get improved
10 crunchiness, get improved shelf life. All of these were unexpected results.

11 There is testing in the application that describes those tests that
12 were run, and so those comparisons do exist in the record where a
13 comparison was made between a product where the dry charge contained all
14 maltitol and no calcium carbonate versus a product that contained 50 percent
15 maltitol and 50 percent calcium carbonate in the dry charge.

16 JUDGE KIMLIN: So your comparison is not with the prior art
17 cited by the examiner, but with using no filler at all?

18 MR. SHURTZ: That is correct. That raises an interesting
19 point.

20 JUDGE KIMLIN: Your reply brief raised an interesting point.
21 It says here the answer cites no support for the position that a comparison of
22 the invention has to be to the art cited in the final rejection and there is no
23 such requirement in the law.

24 Would you like to elaborate on that statement?

25 MR. SHURTZ: Here is the -- yes, I would. At the time that the
26 application was prepared, the prior art that we considered closest prior art

1 was a product that was made the conventional way, which was to use 100
2 percent maltitol in the dry charge. That was the testing that was done.

3 The examiner over the course of the prosecution cited a number
4 of references. We've ended up with two here in front of us today.

5 But if every time the examiner cites a different reference you
6 have to go back and do testing or if the examiner cites a number of
7 references, you could end up testing against every one of those. It would be
8 very time consuming. I don't think the law requires that. So the law
9 requires --

10 JUDGE KIMLIN: You don't think if you tested against zero
11 percent filler, because that was your consideration of the closest art, and the
12 examiner found a reference that was 10 percent less filler, that wouldn't be
13 closer prior art?

14 MR. SHURTZ: It wasn't a question of closer prior art. It was a
15 question of unexpected results compared to, you know, did the invention
16 encompass unexpected results?

17 The issue as I saw it is that we have -- if you get to the point of
18 saying there is a prima facie teaching, then what do we have to do to
19 overcome that prima facie teaching? In my view, you have to show
20 unexpected results. That is what the law requires.

21 Unexpected results compared to what? Is it unexpected result
22 compared to any specific reference that the examiner cites? I don't think so.
23 I think it was unexpected results from what a person of ordinary skill in the
24 art would think. We tested compared to having no filler in the dry charge.

25 And I personally think that if a person of ordinary skill in the
26 art was looking at the prior art, they would have thought -- they wouldn't

1 have expected to get anything different if you used 10 percent or so. It didn't
2 really make any difference whether the prior art was zero or 10, but to put 50
3 percent, which is where we tested, was clearly different, and the results were
4 unexpected.

5 So I think we showed unexpected results, not particularly
6 against the reference and the example that was in the reference cited by the
7 examiner.

8 JUDGE KIMLIN: You are aware of the line of cases that hold
9 the comparison must be to the closest prior art?

10 MR. SHURTZ: No, sir, I'm not.

11 JUDGE KIMLIN: Perhaps the decision will cite those cases.

12 MR. SHURTZ: All right.

13 JUDGE KIMLIN: Is there any evidence that the comparison in
14 your specification would be considered truly unexpected by one of ordinary
15 skill in the art rather than just different?

16 MR. SHURTZ: As I understand your question -- let me repeat
17 it. Is there anything in our specification that suggests that this was
18 unexpected result? Is that it?

19 JUDGE KIMLIN: Suggests or better yet establishes and
20 demonstrates.

21 MR. SHURTZ: Certainly the inventors and by their
22 declaration, which accompanied the application, the application does refer to
23 these results as being unexpected. And therefore, their declaration
24 establishes the truth and veracity of what is in the specification.

25 JUDGE KIMLIN: That is what I was asking is- if the
26 specification states they're unexpected.

1 MR. SHURTZ: Yes. I see on page 17 the applicant stated as
2 noted the use of a high quantity of filler on the dry charge not only reduced
3 the cost of coating, it was found to improve the coating quality such as
4 crunchier coating, increased corner strength, and improved shelf life. So
5 there is one statement that I can find right off.

6 Those are the points I wish to make.

7 JUDGE KIMLIN: Any further questions?

8 JUDGE GARRIS: I have none.

9 JUDGE KIMLIN: I think we understand the issues.

10 MR. SHURTZ: All right. Thank you.

11 JUDGE KIMLIN: Thank you for coming.

12 Whereupon, the proceedings at 11:16 a.m. were concluded.